

## SECOND OFFICE ACTION

### *Amendments*

1. This Second Office Action is in response to the correspondence titled "AMENDMENT IN RESPONSE TO NON-FINAL OFFICE ACTION" received December 16, 2009 and the correspondence titled "SUPPLEMENTAL RESPONSE TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. 1.111" received January 21, 2010. Claims 31-92 are pending.

### *Claim Objections*

2. Claims 81 and 84 are objected to because of the following informalities: It is unclear what is intended by the extraneous "1" after reference numeral "(8)" in claim 81, line 2. The letter "i" in claim 84, line 9, should be "in". Appropriate correction is requested.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 55 and 80 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 55, 74, 80, 87 and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 55 and 80 provide for the "use" of a metal element, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a "use" without any active, positive steps delimiting how this use is actually practiced. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

8. The term "in particular" is indefinite in a claim since it is not clear if the limitations after the phrase are required by the claim or merely suggestive (e.g. see claim 55, line 2; claim 74, line 3; claim 80, line 2; claim 87, line 25; claim 90, line 24). In addition, the use of "in particular" to establish a narrower range together with a broader range is indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or

limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

9. Claims 87 and 90 are indefinite for referring to canceled claims (e.g. see claim 87, lines 25-26; claim 90, lines 24-25).

#### ***Response to Arguments***

10. Applicant's amendments and arguments filed December 16, 2009 have been fully considered and have overcome several of the previously presented rejections, but they are not persuasive with regards to the remaining rejections for the reasons below.

11. Claims 55 and 80 were rejected under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, in the First Office Action because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process and also because

a claim is indefinite under 35 U.S.C. 112, second paragraph, where it merely recites a "use" without any active, positive steps delimiting how this use is actually practiced. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). It is not clear where applicant's response addressed this rejection.

12. As noted in the First Office Action, the term "in particular" is indefinite in a claim since it is not clear if the limitations after the phrase are required by the claim or merely suggestive. Applicant has corrected several instances of the use of "in particular" in the claims, but has not yet corrected its use in all the pending claims. The remaining usages of "in particular" are pointed out in the rejections above.

13. Regarding the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Shirey (U.S. Patent 4,545,170), applicant argues that the pending claims distinguish over this reference. Applicant's arguments are convincing and therefore the rejection over Shirey has been withdrawn.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is

not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman  
Primary Examiner  
Art Unit 1794

Application/Control Number: 10/538,381  
Art Unit: 1784

Page 7

/John J. Zimmerman/  
Primary Examiner, Art Unit 1794

jjz  
April 20, 2010